

***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-14 and 48-49 are pending in the application, with claims 1, 3, 6, 10, 48, and 49 being the independent claims. Claims 15-47 had been previously cancelled. Claims 1 and 6-8 are sought to be amended. Applicants reserve the right to prosecute similar or broader claims, with respect to the amended claims, in the future. Claims 48-49 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

***Examiner Interview***

Applicants' representatives thank the Examiner for her time during a telephonic interview on March 23, 2009. Applicants' representatives and Examiner discussed the claim features, and how they distinguished from the applied references. Tentative agreement was reached that amendments similar to the new claims above may overcome the applied references.

***Rejection under 35 U.S.C. § 103***

Claims 3-5 and 9-14 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Pat. No. 6,611,598 to Hayosh ("*Hayosh*"). Applicants respectfully traverse this rejection.

Claims 3 and 10 recite features that distinguish over the applied references. For example, claims 3 and 10 recite "a check printer [configured to] ... print a p-bit hash value on the MICR line." The Examiner concedes in the Office Action and in the Advisory Action that *Hayosh* does not teach at least the above recited feature of the claims, but instead relies on alleged "intended use" to support the rejection. *See Office Action p. 4, Advisory Action p. 2.* Moreover, the Examiner noted in the March 23rd, 2009 Interview that the rejected claims included merely functional features, and that such features do not carry patentable weight. Under long standing legal precedent, this is an improper position being asserted by the Examiner.

First, the Examiner has ignored the 117 year old Doctrine of Slight Change, which allows for patentability where an old product or process has a new use and the old product or process must be altered, however slightly, to fit the new use discovered by an inventor. See, e.g., *Toplif v. Toplif*, 145 U.S. 156 (1892), *Potts v. Creager*, 155 U.S. 597 (1895), *Hobbs v. Beach*, 180 U.S. 383 (1900), *Traitel Marble Co. v. U.T. Hungerford Bass & Copper Co.*, 18 F.2d 311 (2d Cir. 1927); and *H.C. White v. Morton E. Converse & Son Co.*, 20 F.2d 311 (2d Cir. 1927). Based on the Examiner's own statements in the Office Action, *Hayosh* would need to be more than slightly altered in order to meet the Examiner's alleged new use, thus the claim should be found patentable based on the Slight Change Doctrine.

Second, all features recited in a claim carry patentable weight, including the Examiner alleged functional features, and must be considered during examination. See, e.g., *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796 (Fed. Cir. 1990) *cert denied sub nom Perry v Amerace Corp.* 502 U.S. 808 (1991) (stating functional language, in appropriate

cases, cannot be disregarded); *ACCO Brands, Inc. v Micro Security Devices, Inc.*, 346 F.3d 1075 (Fed. Cir. 2003) (stating the functional language in a claim can be limiting when viewed in light of the specification); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (“The function language is, of course, an additional limitation in the claim”); *Medrad, Inc. v MRI Devices Corp.* 401 F.3d 1313 (Fed. Cir. 2005) (“It is therefore entirely proper to consider the functions of an invention in seeking to determine the meaning of a particular claim language.”); *In re Mills*, 916 F.2d 680, 682-83 (Fed. Cir. 1990) (stating the PTO erred in finding obviousness even when differences “lie solely in the functional language of the claims”); *In re Stencel*, 828 F.2d 751, 755 (Fed. Cir. 1987) (stating claims reciting structure and purpose [functionality] are patentable when there is no suggestion in the prior art of an apparatus having the claimed structure and purpose). Thus, the Examiner must consider all features recited in the claims and not use mere speculation and conjecture to assert that the applied reference *Hayosh* teaches the claims. Accordingly, after according due weight to the above recited feature of “a check printer [configured to] ... print a p-bit hash value on the MICR line,” Applicants respectfully request that the rejection to claims 3 and 10 be withdrawn.

Dependent claims 4, 5, 9 and 11-14 are patentable for at least the same reasons as independent claims 3 and 10, from which they directly or indirectly depend, and further in view of their own respective features. Accordingly, Applicants respectfully request that the rejection to claims 4, 5, 9 and 11-14 be withdrawn.

***Allowable Subject Matter***

As previously noted in earlier communications, Applicants acknowledge with appreciation the Examiner's indication that claims 1, 2 and 6-8 contain allowable subject matter.

***New Claims – Claim 48***

Claim 48 positively recites features that distinguish over the applied reference. For example, claim 48 recites "means for printing ... the p-bit hash value on a MICR line of a check." As the Examiner concedes in the Office Action, *Hayosh* fails to discuss printing the hash value contained in the MICR line of a check. *Office Action*, p. 4. Moreover, Applicants contend that such a distinguishing feature is to be accorded patentable weight, since the feature is written as a means-plus-function element in claim 48. See, e.g., *In re Oelrich*, 666 F.2 578 (CCPA 1981) (stating that a function expressed as a means-plus-function element in a claim suffices to distinguish prior art). Therefore, Applicants respectfully request that the Examiner pass claim 48 through to allowance.

***New Claims – Claim 49***

Claim 49 recite features that distinguish over the applied reference. For example, claim 49 recite "a p-bit hash value processor generating a p-bit hash value based on the ... information." Applicants further note that at least the above-noted distinguishing feature does not include any functional terms. Therefore, Applicants contend that the Examiner cannot rely on what Applicants believe is an improper "functional term" argument to assert that *Hayosh* is "capable of" performing at least the above-noted distinguishing features, or to assert that the distinguishing feature is merely an "intended

use" of *Hayosh*. Thus, the applied reference cannot be used to establish a prima facie case of obviousness, and Applicants respectfully request that claim 49 be passed through to allowance.

### ***Conclusion***

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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